DETAILED ACTION

Response to Arguments

1.   Applicant's arguments, see amendment and remarks, filed 05 August 2011, with respect

to the rejection(s) of claim(s) 92-125 under 103(a) have been fully considered and are

persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration,

a new ground(s) of rejection is made in view of newly discovered art.

2.   This action is non-final because examiner, upon further consideration, determined that

there were 101 and 112 issues in regards to some of the claims.

3.   New claims have been added and existing claims have been heavily amended in scope.

Therefore, new art is applied in light of the new claims.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

5.   Claims 124 – 125 and 145 – 152 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

6.   Claims 124 125 and 145 – 152 are rejected under 35 USC 101 because it fails to be

limited to embodiments which fall within a statutory category.

7.   Claim 124 recites, "a software program product in which a software code is stored, the

software code, when executed, causing an electronic device to perform…" followed by a series

of procedural steps. The specification recites some description on these factors (P. 4, line 5 - P.

5, line 15; P. 44, line 25 - P. 45, line 12) but is silent on the issue of what these terms mean, let

alone what embodiments they encompass.

8.   Note that "a computer program product" can be implemented as software, "embodied on a computer readable media for use by a computer" is a preamble, and a listing of method steps is the body of the claim. The method steps listing in the body of the claim does <u>not</u> breathe life into the preamble. Consequently, <u>no</u> patentable weight is given to the preamble, and the preamble is just an intended use. The claim is just a computer program product which is software that processes the method steps.

9.   The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. *See* MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356 – 57 (Fed. Cir. 2007).

10.   A computer program product, which is a software product, is not a Manufacture within the meaning of 101. In such embodiments, the program is still unable to act as a computer component and have its functionality realized. Thus, claims that recite nothing but computer program, per se. Thus, this embodiment is also non-statutory.

11.   Since it is not until the software program/logic/code/module is converted into an appropriate electronic form to be read and executed by the processor, this embodiment is no more than computer program per se, and therefore non-statutory.

12.   In view of the above analysis, claim(s) 124 and dependent claims are ineligible for patent protection as failing to be limited to embodiments which fall within a statutory category.

13.   Applicant may correct the 101 issue by amending the claim and/or specification to

narrow the scope of the embodiments to statutory embodiments. For example, the applicant may

amend the claim to add the term "non-transitory" or "recordable".

Claim Rejections - 35 USC § 112

14.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

15.   Claims 92 – 152 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

16.   The term "at least in close vicinity" in claims 92 - 152 is a relative term which renders the

claim indefinite. The term "at least in close vicinity" is not defined by the claim, the

specification does not provide a standard for ascertaining the requisite degree, and one of

ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Applicant is advised to provide specifics as to the distance between the two mobile devices.

Claim Rejections - 35 USC § 102

17.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

18.   Claims 92 - 95, 97 - 100, 102 - 104, 106 - 111, 113 - 116, 118 - 122, 124, 127, 129, 130,

135, 137, 138, 143, 146, 148, 149 are rejected under 35 U.S.C. 102(e) as being anticipated by

Wardrop (7,451,217).

19.   For claims 92, 124, Wardrop teaches a method and software product (abstract; col. 1, line

1 – col. 3, line 40; col. 15, line 10 – col. 16, line 45) comprising:

      a.   Detecting, by an apparatus, that a mobile device is at least in close vicinity to

      another mobile device (col. 4, lines 5 – 15; determine short distance to create link), while

      a particular application of the mobile device is a foreground application that is currently

      selected to receive user input (col. 4, line 60 – col. 6, line 10; detection when foreground

      application is browser, file sharing application, etc.); and

      b.   Causing, by the apparatus, the establishment of a communication channel between

      the mobile device and the other mobile device in response to the detection that the mobile

      device is at least in close vicinity (claim limitation broadly interpreted) to another mobile

      device (col. 3, line 40 – col. 4, line 15; establishing ad-hoc network) for enabling a

      transfer of data relating to the foreground application (col. 4, line 60 – col. 6, line 10;

      peer network for purpose of file sharing).

20.   For claim 93, Wardrop teaches that detecting that the mobile device is at least in close

vicinity to another mobile device comprises at least one of: detecting a physical touch between

the mobile device and the other mobile device and detecting a short distance between the mobile

device and the other mobile device (col. 4, lines 5 – 15; determine short distance to create link).

21.   For claims 94, 103, 114, Wardrop teaches that the communication channel is set up

according to one of predefined user preferences and a user input (col. 9, lines 5 – 45; user

supplies technical requirements, query adjustments).

22.   For claims 95, 104, 115, Wardrop teaches performing a security operation for

determining at least one of whether the communication channel is allowed to be established

between the mobile device and the other mobile device and whether the communication channel

is allowed to be used for a specific data transmission (col. 10, line 20 – col. 13, line 40;

authorization tokens to limit usage).

23.   For claims 97, 106, 118, Wardrop teaches automatically invoking at least one function of

the foreground application in the mobile device, in order to enable the at least one invoked

function to interact via the communication channel with another application (col. 6, lines 10 –

35; col. 8, line 15 – col. 9, line 55; upon formation of connection, devices start building and

sharing file lists).

24.   For claims 98, 107, 119, Wardrop teaches that establishing the communication channel is

followed by an automatic context dependent interaction via the communication channel with the

other mobile device (col. 6, lines 10 – 35; col. 8, line 15 – col. 9, line 55; upon formation of

connection, devices start building and sharing file lists).

25.   For claims 99, 108, 120, Wardrop teaches at least one of a copy-and-paste functionality, a

cut-and-paste functionality, and a drag-and-drop functionality in the mobile device makes use of

the established communication channel for interacting with the other mobile device (col. 9, line

55 – col. 10, line 20; copy/paste from source node to requesting node as described in

specification).

26.   For claims 100, 109, 121, Wardrop teaches an exchange of data via the established

communication channel based on a user input to the mobile device (col. 9, line 55 – col. 10, line

20; information retrieved over peer connection based on user input).

27.   For claims 102, 113, Wardrop teaches a system and apparatus (abstract) comprising:

      a.   A touch detection portion, the touch detection portion being configured to detect

that a mobile device is at least in close vicinity to another mobile device (col. 4, lines 5 –

15; determine short distance to create link), while a particular application of the mobile

device is a foreground application that is currently selected to receive user input (col. 4,

line 60 – col. 6, line 10; detection when foreground application is browser, file sharing

application, etc.); and

      b.   A link creation portion configured to cause the establishment of a communication

channel between the mobile device and the other mobile device in response to the

detection that the mobile device is at least in close vicinity to another mobile device (col.

3, line 40 – col. 4, line 15; establishing ad-hoc network) for enabling a transfer of data

relating to the foreground application between the mobile device and the other mobile

device (col. 4, line 60 – col. 6, line 10; peer network for purpose of file sharing).

28.   For claim 110, Wardrop teaches that the apparatus is a mobile device (col. 3, line 40 –

col. 4, line 15; phone and PDA).

29.   For claim 111, 122, Wardrop teaches that the apparatus is a mobile phone (col. 3, line 40

– col. 4, line 15; phone and PDA).

30.   For claims 116, Wardrop teaches that the system comprises at least one of the mobile

device and the other mobile device (claim limitation only requires one mobile device) (col. 3,

line 40 – col. 4, line 15; phone and PDA).

31.   For claims 127, 135, 143, 146, Wardrop teaches detecting that the mobile device is at

least in close vicinity to the other mobile device makes use of a direct link of a first type between

the mobile device and the other mobile device (col. 3, line 40 – col. 4, line 15; WAP), and

wherein said established communication channel uses a direct link of a second type between the

mobile device and the other mobile device (col. 4, lines 5 – 12; Bluetooth).

32.   For claims 129, 137, 148, Wardrop teaches that said data is transferred automatically

(col. 6, lines 10 – 35; col. 8, line 15 – col. 9, line 55; upon formation of connection, devices start

building and sharing file lists).

33.   For claims 130, 138, 149, Wardrop teaches that transferring data via the communication

channel to the other mobile device, the transfer invoking at least one application in the other

mobile device (col. 6, lines 10 – 35; col. 8, line 15 – col. 9, line 55; upon formation of

connection, devices start building and sharing file lists).

Claim Rejections - 35 USC § 103

34.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

35.   Claims 96, 101, 105, 112, 117, 123, 125, 126, 134, 142, 145 are rejected under 35

U.S.C. 103(a) as being unpatentable over Wardrop as applied to claims 92, 102, 113, 124 above,

and further in view of Tan et al. (7,523,220).

36.   For claims 96, 105, 117, Wardrop does not expressly disclose notifying the foreground

application in the mobile device about the communication channel. Tan teaches a method and

system (abstract) of providing ad-hoc peer-peer data sharing (col. 1, line 1 - col. 2, line 60) for

mobile devices (col. 2, line 60 - col. 6, line 55; handheld and tablet devices, game pads,

smartphones) that includes notifying the foreground application (col. 8, line 15 – col. 9, line 55;

message delivery through user application layer). At the time the invention was made, one of

ordinary skill in the art would have added Tan in order to provide better connectivity (col. 1,

lines 25 – 60).

37.   For claims 101, 112, 123, 125, Wardrop does not expressly disclose that said established

communication channel uses a direct link between said mobile electronic device and said other

mobile electronic device, and wherein updating said communication channel comprises replacing

said direct link by an indirect link between said mobile device and said other mobile device. Tan

teaches this limitation (col. 9, line 65 – col. 11, line 30; changing path lengths).

38.   For claims 126, 134, 142, 145, Wardrop does not expressly disclose monitoring

conditions on said established communication channel, and updating said communication

channel in case said conditions are detected to be worse than predetermined conditions. Tan

teaches this limitation (col. 9, line 65 – col. 11, line 30; changing path lengths).

39.   Claims 128, 131-133, 136, 139-141, 144, 147, 150-152 are rejected under 35

U.S.C. 103(a) as being unpatentable over Wardrop as applied to claims 92, 102, 124, 127, 135,

143, 146 above, and further in view of Kovacs et al. (7,516,201).

40.   For claims 128, 136, 144, 147, Wardrop does not expressly disclose that said direct link

of a first type is a radio frequency identification based link, but does disclose wherein direct link

of a second type is a Bluetooth based link (col. 4, lines 5 – 12; Bluetooth). Kovacs teaches a

method and system (abstract) of providing ad-hoc connections for sharing mobile foreground

data (col. 1, line 1 – col. 6, line 60) that includes a direct radio link (col. 6, line 60 - col. 8, line 5;

cellular radio). At the time the invention was made, one of ordinary skill in the art would have

added Kovacs to Wardrop in order to provide greater services sharing (col. 2, line 50 – col. 3,

line 50).

41.   For claims 131, 139, 150, Wardrop does not expressly disclose that the foreground

application is a game, and wherein the data comprises data for invoking the same game as the

other device. Kovacs teaches this limitation (col. 1, lines 40 – 50; multi-user electronic game).

42.   For claims 132, 140, 151, Wardrop teaches that the foreground application is a

multiplayer game. Kovacs teaches this limitation (col. 1, lines 40 – 50; multi-user electronic

game).

43.   For claims 133, 141, 152, Wardrop teaches that the transfer of data is configured to cause

the other device to download an application. Kovacs teaches this limitation (col. 7, line 50 – col.

8, line 5; col. 10, lines 5 – 20; component downloading).

Conclusion

44.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MELVIN H. POLLACK whose telephone number is (571)272-

3887. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MELVIN H POLLACK/
Examiner, Art Unit 2445